

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA**

CORLISS O. BURANDT,)	
)	
Plaintiff,)	
)	
v.)	
)	
KATHERINE K. VIDAL, Under)	Civil Action No. _____
Secretary of Commerce for Intellectual)	
Property and Director of the United)	
States Patent and Trademark Office,)	
)	
Defendant.)	
_____)	

COMPLAINT

Plaintiff Corliss O. Burandt, alleges in his Complaint against Defendant Kathi Vidal, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, in her Official Capacity, as follows:

Nature of the Action

1. This is an action under 35 U.S.C. § 145 of the federal Patent Statute to obtain a patent based on U.S. Patent Application No. 07/516,757 (“the ‘757 application”) having a filing date of April 30, 1990. Plaintiff Corliss O. Burandt (“Mr. Burandt” or “Plaintiff”) is the owner of the ‘757. The ‘757 application was filed as a continuation of U.S. Patent Application No. 178,467, filed April 7, 1988, which issued as U.S. Patent No. 4,961,406 (“the ‘406 patent”).

2. Despite a continuous series of diligent efforts by Plaintiff to obtain a well-deserved patent, Mr. Burandt has met with prejudice, broken assurances, and dilatory tactics on behalf of personnel at the United States Patent and Trademark Office (“USPTO”), including being shunted into the USPTO’s notorious Sensitive Application Warning System (“SAWS”).

The SAWS program was created not by statute, but by the USPTO to “allow patent examiners to alert leadership when a patent might issue on a sensitive matter. Only a small number of applications were ever referred to the SAWS program.¹ Whatever the intended purpose, the SAWS program was roundly criticized for its secretive nature, and its tendency to attack unpopular applicants.

3. According to the USPTO’s website, “SAWS was established in 1994 to alert officials about patent applications that could generate media attention by being controversial or frivolous... applications subject to the program could include those for inventions involving abortion... perpetual motion machines or a cure for AIDS, or inventions with a ‘pioneering scope,’ among many other things.”²

4. The subject matter of the ‘757 patent relates to nothing controversial, but instead to technology that improves automotive performance, which results in lower emissions, by optimizing air-fuel mixtures for internal combustion engines – the inventive technology was both uncontroversial and ahead of its time for being directed to “green” technology.

5. This is a cause of action provided under 35 U.S.C. § 145 for Plaintiff to obtain *de novo* review of the merits of the ‘757 application and for this Court to order the USPTO to issue a U.S. Patent.

The Parties

6. Mr. Burandt is a citizen of the United States and a resident of Anoka, Minnesota. He is an inventor who had a prolific period of design activity over approximately 10 years that

¹ <https://www.uspto.gov/patents/initiatives/patent-application-initiatives/sensitive-application-warning-system#:~:text=March%20%2C%202015%3A%20The%20Sensitive%20Application%20Warning%20System,years%20were%20ever%20referred%20to%20the%20SAWS%20program>

² <https://www.law360.com/articles/1066110/uspto-docs-shed-some-light-on-secretive-saws-program>

resulted in twelve (12) issued patents and several prototype engines that were accepted for evaluation by three major automobile companies. These patents have been cited in later filed patent applications over 150 times including by many different prominent vehicle and engine manufacturers.

7. Defendant Katherine K. Vidal (“Vidal”) is the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office. As Director, Vidal has responsibility for the administration and operation of the USPTO, including the examination of patent applications. She is named in this action only in her official capacity.

Jurisdiction and Venue

8. This action arises under the patent laws of the United States, and this Court has subject matter jurisdiction pursuant to 28 U.S.C. §§1331, 1338(a), and 35 U.S.C. §145.

9. Venue is proper pursuant to 28 U.S.C. § 1391(e) and 35 U.S.C. §145.

10. This Complaint is timely filed in accordance with 35 U.S.C. §145, 37 C.F.R. §90.3(c)(1)(i), and the order granting Plaintiff’s request for an extension of time under 37 C.F.R. § 90.3(3)(c)(1)(i).

The ‘757 Application

11. Burandt is the owner and inventor of the ‘757 application. The ‘757 application was filed on April 30, 1990 and claims priority to the April 7, 1988 filing date of its parent patent U.S. 4,961,406 (“the ‘406 patent”) which issued on October 9, 1990.

12. The ‘757 application includes the following claims: 31, 33, 34, 36-48, 51, 71-77, 79-81, 84-86, 89-93, and 101-134.

13. Burandt seeks to obtain a patent on all the ‘757 claims.

14. The invention relates to a pioneering system and method for optimizing the air-fuel mixture burn rates of an internal combustion engine running at low speed depending on light or heavy load operating conditions. In certain embodiments the engine has variable valve events that provide for a low speed, small valve event, and for earlier than normal intake valve closing. Low speed burn rate can be optimized by adjusting a camshaft phasing mechanism. A phasing mechanism is used to provide phasing control of the operation of the camshaft of the engine relative to the crankshaft. During low speed, heavy load operating conditions the phasing relationship of the camshaft to the crankshaft is advanced and the burn rate is decreased. In certain embodiments, the phasing mechanism includes an electrical servo motor and the load sensor includes a vacuum sensor.

15. Mr. Burandt diligently pursued prosecution of the '757 application when he gained control of prosecution, while the USPTO seemingly did everything they could to delay prosecution since then. The '757 application was allowed by its original examiner, but subsequent to the allowance, the '757 application was moved to the SAWS program, where the allowance was withdrawn. Moreover, while a revival petition was being decided, and the USPTO admitted that the petition to revive took too long to decide, the USPTO lost the '757 file.³

16. Upon information and belief, USPTO examiner Douglas Woods intentionally delayed consideration of a revival petition for the '757 application. The delay is evidenced by the inordinately protracted time it took for the USPTO to grant the petition.

³ Mr. Burandt assigned his interest to Investment Rareties Incorporated through an assignment recorded at the USPTO on August 1, 1988 at Reel/Frame 004925/0548, and then gained it back in an assignment recorded on September 19, 2005 at Reel/Frame 016549/0562.

17. On information and belief, further evidence of the delay was express by then Deputy Commissioner Robert W. Bahr, who admitted in a telephone conference with Mr. Burandt's counsel that the delay was out of line with times to decision on similar petitions. Mr. Bahr further stated in so many words that he was going to "fix the problem" by not only granting the petition but agreeing never to issue a double patenting rejection, thereby avoiding an unfair subtraction of the life of any patent issuing from the '757 application.

18. On information and belief, an internal USPTO memorandum exists or existed, outlining the USPTO's delay and "time out" strategy in handling Mr. Burandt's '757 application.

19. On information and belief, the file wrapper was intentionally lost. Whether intentional or not, the memorandum detailing the USPTO's "time out" strategy for the '757 application may not exist at the USPTO.

20. Upon information and belief, the USPTO authored memorandum discussed reasons the USPTO placed the '757 application in the SAWS program. Placement of the '757 application in the SAWS program led to the '757 application being finally rejected.

21. Upon information and belief, the '757 SAWS memorandum has been produced in discovery under protective order in *Paul Morinville, et al., v. USPTO*, Case 1:19-cv-01779-CKK in the U.S. District Court for the District of Columbia. Mr. Burandt requested a copy of the '757 SAWS memorandum on the record in the '757 application but so far has not been provided a copy. The only reason to deny Mr. Burandt a copy of the memorandum is that it details improper, prejudicial, unfair and non-meritorious bases for denying Mr. Burandt a patent.

22. Statistical analysis has shown that the SAWS program was unfair, at least as it applied disproportionately and much more often to small entities. Mr. Burandt is a small entity and thus SAWS was objectively and unfairly applied to the '757 application.

23. Unfairness of the SAWS program is further evidenced by the fact that the '757 application was determined to be allowable while it was handled by the standard examining procedures, and then unfairly rejected when transferred to the SAWS program for no apparent reason. Examiner McMahon, the pre-SAWS examiner, had intended to allow the '757 application on August 30, 2011, without objection to the specification, or drawings, and without a double patenting rejection.

24. The PTO subjected all of Mr. Burandt's claims to the SAWS program during the period that SAWS was in operation. In accordance with the terms of the SAWS program, examiners lacked authority to allow Mr. Burandt's '757 application. Moreover, under the terms of the SAWS program, examiners and other USPTO officials were directed to consider factors that are irrelevant to the statutory criteria for patentability in determining whether to permit Mr. Burandt's '757 application to issue as a patent. The inclusion of Mr. Burandt's '757 application in the SAWS program prejudiced the USPTO in its consideration of Mr. Burandt's '757 application.

25. A review of the record will show that the '757 application had to endure 15 years of prosecution at the hands of a SAWS examiner and subsequent appeals. The unnecessary and unfair delay was entirely the fault and at the direction of the USPTO.

26. The USPTO placed Mr. Burandt's '757 application in the SAWS program to prevent Mr. Burandt from obtaining a patent and to delay prosecution in a way that would burn off the life of any allowable claims, thus making the pursuit of appeals futile. The double

patenting rejection, initially indicated as not a possibility, became the mechanism for ensuring no surviving patent protection.

27. On information and belief, the treatment endured by Mr. Burandt was a deliberate plan to prevent small size applicants from obtaining patents based on early filing dates. The USPTO has acted in bad faith and in a prejudicial manner towards Mr. Burandt's '757 application.

28. It has been 20 years since the filing of the initial petition to revive the '757 application. The USPTO examiner issued a final rejection of the pending claims, and Mr. Burandt appealed by filing a Notice of Appeal on August 11, 2019. Mr. Burandt's Appeal Brief was filed on January 11, 2019. The examiner filed an Answer on January 5, 2022, and Mr. Burandt filed a Reply brief on March 6, 2022. The Patent Trial and Appeal Board ("PTAB") issued its decision confirming the rejection of all claims on May 17, 2023. Mr. Burandt filed a Request for Reconsideration, and the PTAB rejected the Request on January 31, 2024. Mr. Burandt filed a request for extension of time to file this action, and the request was granted.

The PTAB Decision Violates the APA and Due Process

29. In the Decision on Appeal dated May 17, 2023, the Patent Trial and Appeal Board ("PTAB") denied that USPTO actions and activities in rejecting the '757 patent application violated the Administrative Procedures Act ("APA").

30. The PTAB on multiple occasions stated they "appreciated Appellant's arguments" but found no authority to find that the alleged and proven facts did not demonstrate an APA violation.

31. The failure to acknowledge that the USPTO's examination procedures, particularly those conducted under the since-outlawed SAWS program, violated the spirit and mandates of the APA is erroneous.

32. Although Mr. Burandt argued that the USPTO actions and activities during prosecution of the '757 application, particularly those conducted under the SAWS program, violated his 5th Amendment due process rights, the PTAB decision did not address the issue separately from the APA issue.

33. The Decision did not address Mr. Burandt's constitutional arguments, and did not provide a legal basis for denying to consider those arguments.

34. The failure to find that the actions and activities of the USPTO violated Mr. Burandt's constitutional rights is erroneous.

Objections

35. In the Decision at page 12, the PTAB denied considering the argument that a substitute specification was entered, instead stating that the issue was subject to petition, not appeal.

36. Failure to acknowledge entry of the substitute specification is erroneous.

Non-Statutory Double Patenting Rejection

37. In the Decision, the PTAB affirmed the examiner's requirement for a terminal disclaimer to overcome a non-statutory double patenting rejection of claims 31, 33, 34, 36-48, 51, 71-77, 79-81, 84-86, 89-93, and 101-134 over Burandt '406.

38. The Decision affirmed the examiner's rejection of claims 31, 33, 34, 36-48, 51, 71-77, 79-81, 84-86, 89-93, and 101-134 of the '757 application in view of non-statutory double patenting over Burandt '406 claims 1-10.

39. Claims 31, 33, 34, 36-48, 51, 71-77, 79-81, 84-86, 89-93, and 101-134 of the '757 application are patentably distinct over Burandt '406, Nakano, or Moore.

40. The lack of a requirement for a terminal disclaimer was acknowledged by the USPTO prior to entry of the '757 application into the SAWS program. The subsequent requirement by the USPTO for a terminal disclaimer was an unjust and unfair act of deception and was nevertheless without legal or factual justification.

41. The rejection of claims 31, 33, 34, 36-48, 51, 71-77, 79-81, 84-86, 89-93, and 101-134 on grounds of non-statutory double patenting over Burandt '406 Nakano and Moore is erroneous.

42. The rejection of claims 31, 33, 34, 36-48, 51, 71-77, 79-81, 84-86, 89-93, and 101-134 on grounds of non-statutory double patenting over Burandt '406 is erroneous.

Rejections Based on 35 U.S.C. §102

43. The Decision confirmed the examiner's rejection of claims 51, 80, and 129 as being anticipated under 35 U.S.C. §102 (b) by Muller-Berner.

44. Claims 51, 80 and 129 are not anticipated by Muller-Berner because each element of those claims cannot be found in Muller-Berner, either explicitly or inherently.

45. The Decision affirming the rejection of claims 51, 80, and 129 under 35 U.S.C. § 102 (b) is erroneous.

Rejection Based on 35 U.S.C. §103

46. The Decision confirmed the examiner's rejection of claims 31, 33, 34, 36-48, 51, 71-77, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Muller-Berner.

47. The Muller-Berner reference fails to make a *prima facie* case of obviousness as to claims 31, 33, 34, 36-48, 51, 71-77, 79-81, 84-86, 89-93, and 101-134.

48. The Muller-Berner reference fails to teach or suggest the limitations of claims 31, 33, 34, 36-48, 51, 71-77, 79-81, 84-86, 89-93, and 101-134.

49. The Decision affirming the rejection of claims 31, 33, 34, 36-48, 51, 71-77, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Muller-Berner is erroneous.

50. The Decision confirmed the examiner's rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Hara.

51. The Hara reference fails to make a *prima facie* case of obviousness as to claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134.

52. The Hara reference fails to teach or suggest the limitations of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134.

53. The Decision affirming the rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Hara is erroneous.

54. The Decision confirmed the examiner's rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Burandt '737.

55. The Burandt '737 reference fails to make a *prima facie* case of obviousness as to claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134.

56. The Burandt '737 reference fails to teach or suggest the limitations of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134.

57. The Decision affirming the rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Burandt '737 is erroneous.

58. The Decision confirmed the examiner's rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Burandt '735.

59. The Burandt '735 reference fails to make a *prima facie* case of obviousness as to claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134.

60. The Burandt '735 reference fails to teach or suggest the limitations of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134.

61. The Decision affirming the rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Burandt '735 is erroneous.

62. The Decision confirmed the examiner's rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Takahashi and Burandt '546.

63. The Takahashi and Burandt '546 references fail to make a *prima facie* case of obviousness as to claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 and are improperly combined.

64. The Takahashi and Burandt '546 references fail to teach or suggest the limitations of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 and are improperly combined.

65. The Decision affirming the rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Takahashi and Burandt '546 is erroneous.

66. The Decision confirmed the examiner's rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-127 as obvious in view of Burandt '546.

67. The Burandt '546 reference fails to make a *prima facie* case of obviousness as to claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-127.

68. The Burandt '546 reference fails to teach or suggest the limitations of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-127.

69. The Decision affirming the rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-127 as obvious in view of Burandt '546 is erroneous.

70. The Decision confirmed the examiner's rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Mecham and Webster.

71. The Mecham and Webster references fail to make a *prima facie* case of obviousness as to claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134, and are improperly combined.

72. The Mecham and Webster references fail to teach or suggest the limitations of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134, and are improperly combined.

73. The Decision affirming the rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Mecham and Webster is erroneous.

74. The Decision confirmed the examiner's rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Doi and Hisserich.

75. The Doi and Hisserich references fail to make a *prima facie* case of obviousness as to claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134, and are improperly combined.

76. The Doi and Hisserich references fail to teach or suggest the limitations of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134, and are improperly combined.

77. The Decision affirming the rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Doi and Hisserich is erroneous.

78. The Decision confirmed the examiner's rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Murai and Tominaga.

79. The Murai and Tominaga references fail to make a *prima facie* case of obviousness as to claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134, and are improperly combined.

80. The Murai and Tominaga references fail to teach or suggest the limitations of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134, and are improperly combined.

81. The Decision affirming the rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Murai and Tominaga is erroneous.

82. The Decision confirmed the examiner's rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Oshima and Tominaga.

83. The Oshima and Tominaga references fail to make a *prima facie* case of obviousness as to claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134, and are improperly combined.

84. The Oshima and Tominaga references fail to teach or suggest the limitations of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134, and are improperly combined.

85. The Decision affirming the rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Oshima and Tominaga is erroneous.

86. The Decision confirmed the examiner's rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Nakamura and Tominaga.

87. The Nakamura and Tominaga references fail to make a *prima facie* case of obviousness as to claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134, and are improperly combined.

88. The Nakamura and Tominaga references fail to teach or suggest the limitations of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134, and are improperly combined.

89. The Decision affirming the rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 as obvious in view of Nakamura and Tominaga is erroneous.

Rejection Based on 35 U.S.C. § 112

90. The Decision confirmed the examiner's rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 for failure to have an adequate written description under 35 U.S.C. §112, first paragraph.

91. Claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 of the '757 application have an adequate written description and are fully supported in the specification.

92. The Decision affirming the rejection of claims 31, 33, 34, 36-48, 71-76, 79-81, 84-86, 89-93, and 101-134 for failure to have an adequate written description under 35 U.S.C. §112, first paragraph is erroneous.

Undue Multiplicity of Rejections

93. On information and belief, to discourage and/or dissuade Mr. Burandt from continuing to seek his patent on the '757 application, the USPTO examiner created serpentine, compound, duplicate, and overall, a multiplicity of grounds for rejection.

94. As evident from the Decision, the USPTO rejected the claims on eleven (11) different grounds of obviousness with combinations of multiple prior art references. The USPTO office action stating these multiple obviousness rejections indicates a degree of vindictiveness on the part of the patent examiner against Mr. Burandt. The Manual for Patent Examining Procedure (“MPEP”) informs examiners not to undertake multiplicity rejections.

95. The examiner’s multiplicity of rejections is further evidence of unfair and improper examining tactics employed by the SAWS examiners.

96. The Decision affirming the rejection of all eleven obviousness rejections, without considering whether unfair multiplicity tactics were employed, is erroneous.

Count I: Issuance of a Patent

97. The above paragraphs 1 through 96 are hereby incorporated by reference as if set forth fully herein.

98. The Patent Act, at 35 U.S.C. § 145, provides a cause of action for a patent applicant dissatisfied with a decision of the Patent Trial and Appeal Board to obtain a judgment that the “applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Patent Trial and Appeal Board.”

99. Each of the claims of the ‘757 application was involved in the May 17, 2023 Decision of the Patent Trial and Appeal Board.

100. Each of the claims of the ‘757 application is patentable.

101. Each of the claims of the ‘757 application satisfies all applicable legal requirements for issuance of a patent.

102. Mr. Burandt is entitled to receive a patent on all claims in the ‘757 application, with no terminal disclaimer.

Prayer for Relief

WHEREFORE, Plaintiff respectfully asks that this Court enter Judgment in his favor and that he be granted the following relief:

- A. A decree that Mr. Burandt is entitled to receive a patent for the '757 application on all claims;
- B. A decree that the rejections of all claims of the '757 application are erroneous;
- C. A decree authorizing the Director of the United States Patent and Trademark Office to issue a patent for the subject matter claimed in the claims of the '757 application;
- D. A decree that no terminal disclaimer needs to be filed or is required to issue the '757 application as a patent;
- E. A decree that the specification and drawings of the '757 application comply with the requirements of law; and
- F. Such other and further relief as the Court may deem just and proper.

Dated: May 3, 2024

Respectfully Submitted,

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